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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,871	11/19/2003	Hiroshi Suzuki	3679.002ADIV	9347

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EXAMINER

SELLERS, ROBERT E

ART UNIT PAPER NUMBER

1712

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/717,871	Applicant(s) SUZUKI ET AL.	
	Examiner Robert Sellers	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 6-18 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/331,829.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 6-9, drawn to a composition comprising an epoxy resin, a non-clathrated curing agent and a tetrakisphenol of general formula (I), classified in class 528, subclass 117.
 - II. Claim 10, drawn to a curative for an epoxy resin comprising a clathrate of a tetrakisphenol of general formula (I) and an epoxy-group reactive compound, classified in class 252, subclass 182.25.
 - III. Claims 11 and 13, drawn to a curing accelerator comprising a clathrate of a tetrakisphenol of general formula (I) and an accelerator for the curing of an epoxy resin, classified in class 252, subclass 182.26.
 - IV. Claims 12 and 14, drawn to composition comprising an epoxy resin, a clathrate of a tetrakisphenol of general formula (I) and an accelerator for the curing of an epoxy resin, classified in class 528, subclass 118.
 - V. Claims 15 and 17, drawn to a method for curing an epoxy resin composition containing an epoxy resin and a clathrate of a tetrakisphenol of general formula (I) and an epoxy-reactive curing compound, classified in class 528, subclass 121.
 - VI. Claims 16 and 18, drawn to a method for curing an epoxy resin composition containing an epoxy resin, a clathrate of a tetrakisphenol of general formula (I) and an epoxy-reactive curing compound, and a clathrate of a tetrakisphenol of formula (I) and an accelerator of the curing of an epoxy resin, classified in class 525, subclass 523.

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The inventions are distinct from each other because:

2. Inventions (II or III) and I are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a curing agent for carboxy group-containing thermosetting resins and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. The clathrate of Invention II contains a non-reactive accelerator which is materially different from the epoxy-reactive curing compound in the clathrate of Invention III.

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4. The blend of a non-clathrated curing agent and tetrakisphenol of Invention I is structurally distinct from the clathrate of a tetrakisphenol and an accelerator of Invention IV because the curing agent is reactive with the epoxy resin whereas the accelerator is non-reactive therewith, and the tetrakisphenol chemically envelops the accelerator in Invention IV as opposed to presence of the tetrakisphenol in a blend without any interaction with the curing agent in Invention I.

5. The curing method of Invention V involves a tetrakisphenol-clathrated curing agent as opposed to the materially diverse mixture of a tetrakisphenol-clathrated curing agent together with a tetrakisphenol-clathrated accelerator of Invention VI.

6. The curing methods of Invention V or VI utilizes different combinations of materials from the formulations of Invention I, II, III or IV.

Restriction for examination purposes as indicated is proper because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification.

This application contains claims directed to the following patentably distinct species of the claimed invention:

a) Contingent upon the election of any one of Invention I, II or V, the epoxy-group reactive curing compounds wherein a single species is identified from page 22 of the specification.

b) Contingent upon the election of any one of Invention III, the accelerators wherein a single species is chosen from page 22.

c) Contingent upon the election of Invention VI, both the epoxy-reactive curing compounds and the accelerators wherein a single species of each is selected from page 22.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species ***within each of items a) and b), and c) if appropriate***, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 6-18 are generic.

A reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

A telephone call was made to Dennis G. LaPointe on November 1, 2005 to request an oral election to the above restriction and election of species requirements, but did not result in elections being made. The reply to this requirement to be complete must include an election of the invention and species to be examined even though the requirement be traversed (37 CFR 1.143).


Upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. The specification on page 1 according to the preliminary amendment filed November 19, 2003 does not update the status of parent application no. 09/331,829 as U.S. Patent No. 6,727,325.

8. Japanese priority application no. 177468-1997 filed July 2, 1997 was not filed with the other priority applications in parent application on June 23, 1999 in parent application no. 09/331,829.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

rs
11/30/2005



ROBERT E.L. SELLERS
PRIMARY EXAMINER